

U.S. Patent Application Serial No. 10/030,099
Response filed February 11, 2005
Reply to OA dated September 14, 2004

REMARKS

Claims 1-12 are pending in this application. Claims 1, 6, 7 and 8 have been amended hererin.

Claims 1, 7 and 8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which applicant regards as the invention. Claim 7 and 8 recites the limitation “the ink layer”. This is insufficient antecedent basis for this limitation in the claim. (Office action paragraphs no. 2-3)

The rejection is overcome by the amendments to claims 1, 6, 7 and 8, which have been made for clarity.

The Examiner states that the term “print film” is unclear in claims 1 and 7. In particular, the Examiner refers to the recitation in claim 7 of “the ink layer of oil-based ink” and “the print film of the oil-based ink”. In addition, the Examiner indicates that there is insufficient antecedent basis for “the ink layer” in claims 7 and 8.

In the amendments to claims 1, 6, 7 and 8, the recitations of “print film” have been amended to –printing ink film–. In claims 7 and 8, the recitations of “the ink layer of the oil-based ink” have been amended to –the printing ink film of the oil-based ink–. Support for the recitation of “printing ink film” may be found in the specification on page 9, line 11.

The amendment to the term “printing ink film” clarifies that this recited element is a film of printing ink that has been printed by a printing method as recited in claim 1. The amendment also

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clarifies that, in claims 7 and 8, which require an oil based ink, what was previously recited as the “ink layer of the oil-based ink” is the “printing ink film of the oil-based ink”.

Claims 7, 8 and 11 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject which applicant regards as the invention. (Office action paragraph no. 4)

The rejection is overcome by the amendments to claims 7 and 8.

The Examiner indicates that there is insufficient antecedent the phrase “the layer adjoining the print film.” Applicant notes that in the amendment, “print film” has been amended to “printing ink film”, as discussed above.

With regard to the present rejection, claims 6 and 7 have both been amended to positively recite “the receiving layer comprising a layer adjoining the printing ink film of the oil-based ink”, therefore providing antecedent basis for the later recitation of “the layer adjoining the printing ink film of the oil-based ink.”

Claims 1, 6 and 9 of this application conflict with claim 8 of Application No. 09/734,767.

(Office action paragraph 5)

The rejection of claims 1, 6, and 9 over claim 8 of USSN 09/734,767 is respectfully traversed.

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In Applicant's understanding, the present text of claims 1 and 8 of the '767 application reads:

1. A print creating method for prints on which are printed variable information and constant information is printed, the print creating method comprising:

a. an imaging step in which a target is imaged and digital image data of said target is created,

b. a conversion step in which said digital image data is converted to print-processable print data and

c. a printing step in which said print data is printed with an ink-jet recording system as said variable information on said variable region of a recording sheet comprising a constant region in which prescribed constant information printed beforehand and a variable region in which variable information is able to be printed.

8. A print comprising

a. a printing sheet,

b. constant information printed on said printing sheet by offset printing or the like,

c. a coating layer which is coated on said printing sheet and on which ink-jet recording ink is printed, and

d. variable information printed on said coating layer by a print creating method according to any one of claims 1 to 4.

Applicant submits that claim 1 of the present application is not identical with claim 8 of the '767 application since the latter includes process limitations a., b, and c. recited in claim 1 of the '767 application. These are a. an imaging step, b. a conversion step, and c. a printing step involving ink-jet printing. In particular, printing step c. recites that "prescribed constant information is printed **beforehand**" (emphasis added), i.e., before the variable information.

These are not found in present claims 1, 6, and 9.

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Claims 1, 6 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 09/734,767. (Office action paragraph 7)

The obviousness-type double patenting rejection of claims 1, 6 and 9, is respectfully traversed.

As noted above, claim 1 of the present application is not identical with claim 8 of the '767 application since the latter includes process limitations a., b, and c. recited in claim 1 of the '767 application. Applicant submits that the present claims are not obvious over claim 8 of the '767 application.

Claims 1, 6 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by USPN 5,829,700 to Phillips. (Office action paragraph 8)

The rejection of claims 1, 6 and 9 is respectfully traversed.

The Examiner states that Phillips teaches a greeting card (printed matter) comprising a paper sheet 12 of an ink jet printed with a color ink jet printer (variable information is formed). The greeting card can be preprinted lithographically with any desired theme (print film containing fixed information printed).

However, Applicant respectfully disagrees that Phillips explicitly discloses the combination of a greeting card comprising a paper sheet for ink jet printing, wherein the variable information is formed by a color ink jet printer, and the fixed information is preprinted lithographically.

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The relevant disclosures of Phillips are as follows: Phillips discloses a greeting card kit 10 having a greeting card portion 20 and an integrated sticker portion 30 (col. 2, lines 11 to 13). The greeting card kit 10 comprises a single sheet of paper 12 (col. 2, lines 26 to 27). Paper sheet 12 can be paper stock, including bond, laser, ink jet, tag, ledger, vellum, offset, etc. (col. 2, lines 16 to 17). Personalized greetings and information 26 may be added by hand, type writer or computer generation (col. 2, lines 53 to 54). The unique one-piece integrated construction makes it compatible with today's home computer PC's having non-impact printer output such as color ink jet and laser (col. 1, lines 45 to 47).

Thus, the manufacturing technology of the greeting card disclosed in Phillips involves many choices, and simple selection of such choices would not lead to the specific combination of a greeting card comprising a paper sheet 12, where the variable information is formed by a color ink jet printer and the fixed information is preprinted lithographically. Further, Phillips does not explicitly disclose a receiving layer for an ink jet recording ink.

Moreover, the combination suggested by the Examiner, of a greeting card (printed matter) comprising a paper sheet 12 of an ink jet printed with a color ink jet printer (variable information is formed) and the greeting card preprinted lithographically with any desired theme (print film containing fixed information printed), would yield a greeting card comprising a paper sheet 12 having a receiving layer for ink jet ink thereon, and stickers 34 printed on the receiving layer by lithography printing.

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However, it is impossible to form a printed image on the receiving layer for water based ink jet ink by lithographic printing using oil based ink. This combination of elements of the reference would not be functional.

The printed matter of the present invention has a structure wherein the receiving layer and the printing ink film are present on printing paper in a side-by-side relationship, or a structure wherein the receiving layer is present on the printing ink film formed on printing paper. These structures enable the formation of the receiving layer on the printing paper or the printing ink film.

Claims 1, 6 and 9 are therefore not anticipated by nor obvious over Phillips.

Claims 2-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al. (Office action paragraph 11)

The rejection of claims 2-5 is respectfully traversed.

Applicant has argued above that base claim 1 is not anticipated by, nor obvious over, Phillips. Phillips does not teach or suggest the structure of the present invention, which enables the formation of the receiving layer on the printing paper or the printing ink film. Applicant submits that the deficiency in the *prima facie* case of obviousness for claim 1 over Phillips is not cured by the disclosure of Otani et al. '449.

Otani discloses an ink jet recording paper having on at least one side of a base paper at least two ink-receiving layers (abstract). The Examiner cites Otani '449 in column 3, lines 25-28, in

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particular, for the teaching of two ink receiving layers. However, as noted, this disclosure does not provide a suggestion for the combination recited in claim 1.

Claims 2-5 are therefore novel and non-obvious over Phillips and Otani et al., taken separately or in combination.

Claims 10 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 5,829,700 to Phillips in view of USPN 6,214,449 to Otani et al., and further in view of USPN 6,708,612 to Schmid. (Office action page 6)

Applicant has argued above that base claim 1 is not anticipated by, nor obvious over, Phillips. Phillips does not teach or suggest the structure of the present invention, which enables the formation of the receiving layer on the printing paper or the printing ink film. Applicant submits that the deficiency in the *prima facie* case of obviousness for claim 1 over Phillips is not cured by the disclosures of Otani et al. '449 and Schmid.

The Examiner cites Schmid '612 for teaching a printing machine for printing sheets using an in-line operation, ink jet printers, and anilox rollers. In Schmid, an ink jet printer may be used as the non-impact printer 78-81 (column 6, lines 23-25). As noted, this disclosure does not provide a suggestion for the combination recited in claim 1.

Moreover, claim 10 recites that fixed information is printed, and **then** the receiving layer for receiving ink jet ink is formed. This is clearly inconsistent with Phillips, in which use of ink jet

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paper as the base paper would clearly involve forming the ink jet receiving layer **before** lithographic printing. In addition, Otani does not suggest this limitation of claim 10.

Claims 2-5 are therefore novel and non-obvious over Phillips, Otani et al., and Schmid, taken separately or in combination.

In view of the aforementioned amendments and accompanying remarks, the claims, as amended, are in condition for allowance, which action, at an early date, is requested.

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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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